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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,246	07/29/2003	Yasuhiro Oda	Q76692	5446

7590 07/12/2005  
SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

DANIELS, MATTHEW J

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/628,246

Applicant(s)

ODA ET AL.

Examiner

Matthew J. Daniels

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. The claim to domestic priority should be revised to indicate that the parent application has now issued as USPN 6716500.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 8-12 and 14** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/071,444. Although the conflicting claims are not identical, they are not patentably distinct from each for the following reasons:

3. **Claim 8** of the instant application appears to be the same as Claim 1 of the 11/071,444 application with the exception of the phrase "followed by heat setting" added in Claim 1 of the '444 application. This would have been an obvious aspect in the heated female mold and the plug configuration, and heat setting would have obviously or inherently formed the film into its desired shape. **Claims 9-12** appear to be duplicates of Claims 2-5 of the '444 application, and

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therefore the subject matter of these claims is also obvious over the subject matter of the '444 application. Although stated differently, **Claim 14** of the instant application appears to claim the same temperature range of the plug as that of Claim 7 of the '444 application, and therefore this claimed subject matter is also obvious over that of the '444 application.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 11 and 13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **As to Claim 11**, this claim is held to be indefinite because the Applicant's figures (all of them) appear to indicate that the surface area of the plug is the same as the to-be-molded area of the resin sheet by virtue of the fact that the thermoplastic sheet appears to conform to the shape of the plug as the final processing step. In this case, are the to-be-molded area and the plug surface area not the same? Is the claim directed to only the bottom portion of the article to be molded, namely the face upon which a molded cup would sit? Appropriate correction is required to clarify what surface area comparison is being made in this case. **As to Claim 13**, the action and order claimed for using the compressed air makes this claim indefinite because a molding step is claimed "prior to effecting the molding with the compressed air, is molded with the compressed air." If the claimed molding step is taking place

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before the molding with compressed air, it (the molding step) cannot also be produced by the compressed air. The order is unclear, and it appears by the use of the words “prior” and “separate step” that a particular order is desired. Appropriate revision is required to reflect the desired order.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 8-10 and 12** are rejected under 35 U.S.C. 102(b) as being anticipated by Hrivnak (USPN 4388356). **As to Claim 8**, Hrivnak teaches a method of producing a heat resistant resin container (1:45-54) by molding a thermoplastic resin sheet (2:66-68) by using the compressed air (8:9-28) into the shape of a female mold (Fig. 9, Item 30) that is heated at a temperature not lower than the crystallization temperature of said resin (5:43-54 and 6:48-51), and reducing the pressure in the molded article so as to shrink into the shape of a plug having the shape of a final container to impart the shape thereto (8:35-38), followed by cooling (This aspect is inherent by the removal of the cup from the mold). **As to Claim 9**, Hrivnak teaches a method of producing a heat resistant resin container wherein a primary molded article obtained by stretching a thermoplastic resin sheet by using a plug (Fig. 9, Item 10), is molded with the compressed air (8:9-15). **As to Claim 10**, Hrivnak teaches a method of producing a heat resistant resin container wherein the thermoplastic resin sheet is an amorphous sheet of a thermoplastic polyester (1:55-

64). **As to Claim 12**, Hrivnak teaches a method of producing a heat resistant resin container (See Claim 8 above) wherein the temperature of the plug is not lower than a glass transition point of the thermoplastic resin but is not higher than the temperature of the female mold (6:51-56).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hrivnak (USPN 4388356). It should also be noted that Claim 11 was rejected under 35 USC 112, second paragraph, for failure to distinctly claim the subject matter sought. In this case, it is submitted that if the Applicant's inventive method shown in Figures 6-30 meets the claimed limitation, then the method of Hrivnak would have also inherently or obviously met this limitation. Note the strong similarity between the methods and articles shown in Figures 6-30 of the instant application and Figures 4-8 of the reference.

**Claims 11, 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hrivnak (USPN 4388356) in view of Tigner (USPN 3338997). Hrivnak teaches the subject matter of Claim 8. See the rejection of Claim 8 under 35 USC 102(b). **As to Claim 11**, Tigner teaches molding the bottom of the cup (See Fig. 6), and the area of the plug would have inherently been at least 3 times as great as the to-be-molded area in this case (the area contacting Tigner's item

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42 in Fig. 6), meeting the claimed limitation. It would have also been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Tigner into that of Hrivnak in order to provide plastic film containers (2:39) by a less expensive method (1:39-45), having the desirable ability to vary the bottom wall thickness and weight (3:52-70).

**As to Claim 13**, the rejection of Claim 13 under 35 USC 112, second paragraph, should be noted for failure to distinctly claim the subject matter sought. The rejection of Claim 13 under 35 USC 103(a) is set forth with the Examiner's best understanding from the specification as to the subject matter claimed. Hrivnak teaches a method of producing a heat resistant resin container wherein an intermediate article is obtained by stretch-molding the thermoplastic resin sheet by using a plug for stretch-molding (See Fig. 5), and is shrunk in a separate step by being supported by a plug for imparting the shape (8:35-40). Hrivnak additionally teaches air pressure applied beneath the female mold surface to release the molded article, force the oriented polyester to the recess in the male plug (8:48-49) and promote the desired contact with the male plug (8:47-58). Additionally, Tigner teaches that the bottom of the container can be formed first or at any later time to gain the desired bottom characteristics (1:37-40). In view of Tigner's teachings, it would have been prima facie obvious to perform the forming of the bottom at any time in the cycle. It would have also been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Tigner into that of Hrivnak in order to provide plastic film containers (2:39) by a less expensive method (1:39-45), having the desirable ability to vary the bottom wall thickness and weight (3:52-70). **As to Claim 14**, Hrivnak teaches a method of producing a heat resistant resin container, wherein the temperature of the plug for imparting the shape is lower than a glass transition point of the thermoplastic resin (6:51-56).

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*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are cited to further indicate the state of the art at the time of the invention:

Kawaguchi (USPN 4420454)

Fortin (USPN 5683648)

Hahn (USPN 4496408)

Murley (USPN 4536148)

Jakobsen (USPN 4381279)

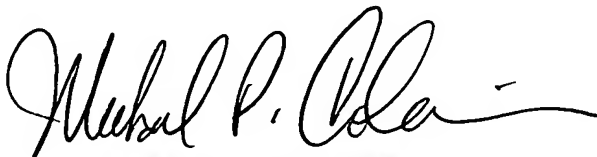
Wolf (USPN 3814784)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Thursday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 6/29/05



**MICHAEL P. COLAIANNI**  
**SUPERVISORY PATENT EXAMINER**